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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,878	09/12/2003	Karnail S. Atwal	HA726 DIV	6964

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EXAMINER	
RAO, DEEPAK R	

ART UNIT	PAPER NUMBER
1624	

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action **Before the Filing of an Appeal Brief**	**Application No.** *10/660,878*	**Applicant(s)** ATWAL ET AL.
	Examiner Deepak Rao	**Art Unit** 1624

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 June 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires _____months from the mailing date of the final rejection.
   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *see attached*. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

Deepak Rao
Primary Examiner
Art Unit: 1624

S.O.B

ADVISORY ACTION

1. Claims 69-77 and 79 are rejected under 35 U.S.C. 112, first paragraph, for the reasons provided in the previous office action, which are incorporated here by reference. Applicant's arguments are not seen to support the entire scope of the claims for the reasons already provided in previous office actions. The state of the art reference(s) filed in the application prior to the final rejection have been fully considered and were responded to in the previous office action. It is maintained that the there is not seen sufficient guidance provided in the form of administration profiles, combination ratios of the active agents or references to same in the prior art to provide the skilled artisan with sufficient guidance to practice the instant therapeutic methods. The references are not seen to provide sufficient evidence of enablement for the treatment of generic groups of diseases recited in the claims, e.g., gastrointestinal disorders, inflammatory and immunological diseases, etc. generally and accordingly, the rejection is maintained.

The claims are drawn to treatment of several types of generic diseases that can be treated by the compounds of the instant invention and the specification does not provide sufficient enabling disclosure commensurate in scope with the claims. Applicant has not provided any nexus between the activity disclosed for the claimed compounds and the treatment of all types of diseases of the instant claims. A detailed discussion based on several state of the art references provided in the previous office action that established the uncertainty of the clinical consequences related to many of the diseases encompassed by the instant claims. The issue particularly with the instant claims is the correlation between the assays provided in the specification and clinical efficacy for the treatment of the various diseases of the instant claims. The extensive list of diseases encompassed by the instant claims includes gastrointestinal

disorders, inflammatory or immunological diseases, etc.

> *In re Vaeck*, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991) (Given the relatively incomplete understanding in the biotechnological field involved, and the lack of a reasonable correlation between the narrow disclosure in the specification and the broad scope of protection sought in the claims, a rejection under 35 U.S.C. 112, first paragraph for lack of enablement was appropriate.).

Hence, in the absence of a showing of correlation between all the diseases claimed as capable of treatment by the potassium channel inhibitors, one of ordinary skill in the art would be unable to fully predict possible results from the administration of the compounds of the claims due to the unpredictability of the role of the potassium channel inhibitors.

Determining if any particular claimed compound would treat any particular type of disease would require synthesis of the compound, formulation into a suitable dosage form, and subjecting it to clinical trials with a number of fundamentally different diseases, or testing them in an assay known to correlate to clinical efficacy of such treatment. There is a large degree of experimentation involved. There is no working example of treatment of any disease in man or animal, the assays provided in the specification are not commensurate in scope of this requirement.

2. Applicant presents new claims 86-90 and proposes an amendment to the definitions of R^{5*} and R^{6*} and relies on the amendment to overcome the rejections over Tsuda et al., EP 217,142 under 35 U.S.C. 102(b) and 103(a) of the previous office action. First, there is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented. Next, the amendments raise new issues that would require further consideration under the guidelines of 35 U.S.C. 112, first and second paragraphs. See e.g.,

MPEP § 2163.05 [R-2] - The introduction of claim changes which involve narrowing the claims by introducing elements or limitations which are not supported by the as-filed disclosure is a violation of the written description requirement of 35 U.S.C. 112, first paragraph.

Further, applicant's arguments and the citations of various case laws were reviewed, however, not considered to overcome the rejection under 35 U.S.C. 103(a) of the previous office action. While the proposed amendment excludes the reference disclosed compounds, the claims continue to include structural analogs that would render the instant claims obvious over the reference. One of ordinary skill in the art would have been motivated to prepare the structural analogs of the reference compounds with the reasonable expectation that such compounds would have the pharmaceutical therapeutic activity. Therefore, it has been held that the claimed method using compounds that are structurally analogous to the reference disclosed compounds is prima facie obvious, absent a showing of unexpected results.

3. The proposed amendments are not deemed sufficient to overcome the obviousness-type double patenting of the previous office action over U.S. Patent No: 6,706,720. The proposed claims continue to overlap the reference claims, see the definition of R^{5*} and R^{6*} which are drawn to form a substituted heterocyclic group. 35 U.S.C. 121 requirements have been fully considered, however, as explained in the previous office action, the instant application can not be considered as being filed in accordance with the restriction requirement of the original application because the group of compounds of the instant claims were not subdivided in the original application and the instantly filed application continues to contain claims to a genus which includes the subgenus that was issued in the parent application.

If entered, the amendment to claim 84 would overcome the rejection under 35 U.S.C. 112, second paragraph of the previous office action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (571) 272-0672. The examiner can normally be reached on Tuesday-Friday from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, Acting-SPE of 1624, can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300..

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Deepak Rao
Primary Examiner
Art Unit 1624

July 14, 2005